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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,386	01/11/2002	Kazuo Fujiura	P 284993 T4KM-01S1334-1	5480
909	7590	10/12/2005	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102			AGUSTIN, PETER VINCENT	
			ART UNIT	PAPER NUMBER
			2652	

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/042,386	Applicant(s) FUJIURA, KAZUO	
	Examiner Peter Vincent Agustin	Art Unit 2652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 July 2005.  
 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-22 is/are pending in the application.  
     4a) Of the above claim(s) 5-9, 13 and 15-20 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-3, 10-12, 14, 21 and 22 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☒ Claim(s) 1-3 and 5-22 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

*W*

### DETAILED ACTION

1. Claims 1-3 & 5-22 are now pending, with claims 5-9, 13 & 15-20 withdrawn from further consideration due to a previous restriction requirement. Claims 1-3, 10-12, 14, 21 & 22 are being examined.

#### *Continued Examination Under 37 CFR 1.114*

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 29, 2005 has been entered.

#### *Claim Objections*

3. Claims 14 & 21 are objected to because they are substantial duplicates of one another.
4. Claim 22 is objected to because it has limitations that are redundant (see base claim 1).

#### *Claim Rejections - 35 USC § 112*

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-3, 10-12, 14, 21 & 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 6 describes that the peripheral side is provided with “**at least one** notch or groove” which encompasses a peripheral side having **only one** notch or groove. Claim 1, lines 8-10 then describes that the peripheral side is “provided with a **plurality** of portions, **each** having

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said **at least one** notch or groove”. The recitation that **each** of a **plurality** of portions has **at least one** notch or groove is inconsistent in a case where there is **only one** notch or groove. Therefore, this claim is indefinite.

Claims 2, 3, 10-12, 14, 21 & 22 are dependent upon claim 1.

7. The following art rejections are made as best interpreted by the Examiner in light of the 112-2<sup>nd</sup> paragraph rejection.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 10-12, 14, 21 & 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Mogi et al. (JP 08-249802; see machine translation).

In regard to claim 1, Mogi et al. disclose an information storage medium (Drawing 1) comprising a disc-like shape substrate having a center hole and a peripheral side (107), said medium comprising: a data area formed on the substrate and configured to store or record information; a clamp area located outside the center hole and inside the data area; and at least one notch or groove provided on at least one portion of the peripheral side (see Drawing 1(b), upper half of the drawing: this is interpreted by the Examiner as having “one notch” regardless of its size along the circumferential direction of the upper half of the peripheral side), said at least one notch or groove being formed at an edge of the peripheral side to enable tactual recognition (paragraph 14, line 4: “finger”) of the notch or groove and said peripheral side being provided

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with a plurality of portions (e.g., upper half and lower half of Drawing 1 (b)), each having said at least one notch or groove (the upper half is shown to have one notch and the lower half is shown to have one notch).

In regard to claim 2, Mogi et al. disclose that said medium is an optical disc formed of a single disc substrate (suggested by “CD” on paragraph 20, line 4).

In regard to claim 3, Mogi et al. disclose that said medium is an optical disc (see title) formed of double disc substrates being adhered together with a given adhesive (see Drawings 1(a) and 1(b); paragraph 14, line 2).

In regard to claim 10, Mogi et al. disclose that said medium comprises a front surface and a rear surface (paragraph 14, line 2: “double-sided”), and wherein said data area is provided on the front surface (interpreted as the surface where data is recorded).

In regard to claim 11, Mogi et al. disclose that said data area is also provided on the rear surface (understood from paragraph 14, line 2: “double-sided lamination disk”, i.e., a DVD).

In regard to claim 12, Mogi et al. disclose that a label area is provided on the rear surface (suggested by paragraph 4).

In regard to claim 14 & 21, Mogi et al. disclose that said at least one notch or groove is configured to indicate a type, or a kind, or a medium side, or contents of the medium (paragraph 12, line 5: “perform distinction”).

In regard to claim 22, Mogi et al. disclose that said peripheral side is provided with a plurality of portions (e.g., upper half and lower half of Drawing 1 (b)) each having said at least one notch or groove (the upper half is shown to have one notch and the lower half is shown to have one notch).

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10. Claims 1, 10, 12, 14, 21 & 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Lissiansky (US 2,565,035).

In regard to claim 1, Lissiansky discloses an information storage medium (Figure 1: R) comprising a disc-like shape substrate having a center hole (122) and a peripheral side, said medium comprising: a data area formed on the substrate and configured to store or record information; a clamp area located outside the center hole and inside the data area; and at least one notch or groove (32, 86) provided on at least one portion of the peripheral side, said at least one notch or groove being formed at an edge of the peripheral side to enable tactual recognition (inherent, see MPEP § 2112.01) of the notch or groove and said peripheral side being provided with a plurality of portions, each having said at least one notch or groove.

In regard to claim 10, Lissiansky discloses that said medium comprises a front surface and a rear surface, and wherein said data area is provided on the front surface (interpreted as the surface where data is recorded).

In regard to claim 12, Lissiansky discloses that a label area (Figure 1: L) is provided on the rear surface.

In regard to claims 14 & 21, Lissiansky discloses that said at least one notch or groove is configured to indicate a type, or a kind, or a medium side, or contents of the medium (inherent, see MPEP § 2112.01).

In regard to claim 22, Lissiansky discloses that said peripheral side is provided with a plurality of portions each having said at least one notch or groove (as shown in Figure 1).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 3 & 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lissiansky.

For a description of Lissiansky, see the rejection above. However, Lissiansky does not disclose: in regard to claim 2, that said medium is an optical disc formed of a single disc substrate; in regard to claim 3, that said medium is an optical disc formed of double disc substrates being adhered together with a given adhesive; and in regard to claim 11, that said data area is also provided on the rear surface.

In regard to claim 2, Official Notice is taken that both the concept and advantages of using "compact discs", i.e., an optical disc formed of a single disc substrate, are notoriously old and well known in the art; and in regard to claims 3 & 11, Official Notice is taken that both the concept and advantages of using "digital versatile discs", i.e., an optical disc formed of double disc substrates being adhered together with a given adhesive wherein a data area is provided on both a front surface and a rear surface, are notoriously old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time of the invention by the Applicant to have used a "compact disc" or a "digital versatile disc", as these types of recording media are known to provide a more reliable and higher density storage of data.

*Response to Arguments*

13. Applicant's arguments filed July 29, 2005 have been fully considered but they are not persuasive.

a. The Applicant argues on page 7, paragraph 2 that “the optical disk [of Mogi et al.] cannot be construed as having a plurality of portions along the edge of the peripheral side”. This argument is not persuasive because the phrase “along the edge of the peripheral side” is not a claimed limitation.

Nevertheless, had this been a claimed limitation, Mogi et al. would still anticipate this feature. The term “portion” is a broad term which can be interpreted as “any section”. The optical disk of Mogi et al. has “a plurality of portions along the edge of the peripheral side”, which can correspond to e.g., four equally divided portions along the edge of the peripheral side, each portion having an angle of 90° along the circumferential direction.

b. The Applicant argues on page 7, paragraph 2 that the optical disk of Mogi et al. cannot be “construed as having at least one notch or groove within each of the portions”. The Examiner disagrees. As noted in the 102 rejection above, Drawing 1(b) shows an upper half and a lower half, which correspond to the claimed “portions”. Each half shows a cut portion, which is interpreted by the Examiner as “one notch”, regardless of its size along the circumferential direction of the peripheral side.

Inasmuch as the Applicant intends to claim the limitation “a plurality of portions along the edge of the peripheral side” (see item a above), Mogi et al. would still anticipate the feature that the plurality of portions (e.g., four equally divided portions



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along the edge of the peripheral side, each portion having an angle of 90° along the circumferential direction) each having said at least one notch or groove (as noted, Drawing 1(b) shows cut portions, each being interpreted by the Examiner as “one notch”, regardless of its size along the circumferential direction of the peripheral side). Therefore, each “plurality of portions” have “said at least one notch or groove”, as required by claim 1.


***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Vincent Agustin whose telephone number is 571-272-7567. The examiner can normally be reached on Monday-Friday 9:30-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on 571-272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peter Vincent Agustin  
Art Unit 2652

  
**BRIAN E. MILLER**  
**PRIMARY EXAMINER**